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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,665	10/27/2003	Oded Katzman	25794	9659

20529 7590 04/27/2007
NATH & ASSOCIATES
112 South West Street
Alexandria, VA 22314

EXAMINER

ACKUN, JACOB K

ART UNIT	PAPER NUMBER
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3723

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	04/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/693,665

Applicant(s)

KATZMAN ET AL.

Examiner

Jacob K. Ackun Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/22/07.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. The Response of 1/22/07 to the Election of Species Requirement of 12/06 is acknowledged. However, it appears from the claims indicated by applicants as being subject to examination, that applicants may have misunderstood the Election of Species Requirement, the intention of which was to afford applicants the opportunity to elect in a second tier, one of the species of the invention of the lens blank applicant had first elected. See paragraph one of the last office action. Accordingly both the Restriction and Election Requirements are made below to clear up any confusion. Applicant is required to first elect an invention from the specified groups. Applicant is then required to elect a single species of that invention and to indicate which claims are readable on that species, as indicated below.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-23, 37-39 and 46-48, drawn to a method of processing a lens face, classified in class 451, subclass 42.
- II. Claims 24-36, drawn to a lens blank, classified in class 428, subclass 64.1.
- III. Claims 40-45, drawn to an adapter for holding a lens blank, classified in class 65, subclass 323.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another and materially different apparatus such as one not having an engagement zone as required in claim 40.

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4. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as one in which the lens blank is not gripped by a gripping device or is not gripped by reliance on reference datum indications.

5. Inventions III and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a materially different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the apparatus as claimed is not an obvious apparatus for making the product.

6. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

8. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

AFTER THE APPLICANTS ELECT ONE OF THE GROUPS ABOVE ELECTION OF SPECIES AS INDICATED BELOW IS ALSO REQUIRED.

9. This application contains claims directed to the following patentably distinct species:

There are various patentably distinct species based on the different reference datum indicators as follows:

Group 1, a peripheral rim 20 having a known thickness dimension as shown in the Fig 1A embodiment;

Group 2, circumferentially extending peripheral groove or recesses as shown at 48 in the embodiment of Fig 1B, for example;

Group 3, axially extending peripheral groove or recess as shown at 52 in the embodiment of fig 1B, for example;

Group 4, tapering wall or tapering peripheral surface of lens blank (see Fig 1C, for example);

Group 5, cylindrical peripheral surface of lens blank (as described, for example, in connection with fig 2B);

Group 6, axial length formed by processing an outer surface to form a cylindrical portion thereof (as shown at L in Fig 2A and T in Fig 4B, for example);

Group 7, front face of a peripheral shoulder (see 96 Fig 2C, for example)

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Group 8, face of lens (see Fig 4B);

Group 9, a single annular shoulder (see S in fig 4B);

Although not a part of the lens blank as far as the examiner can tell from the specification, the adapter ring has various reference datum indications such as hole 198. One or more of these may have been claimed as part of the lens blank (see, for example, claim 33). Also, it is noted that the blocker is disclosed as having various datum indicators. Each different indicator is restricted into its own group to the extent the particular indicator has not already been identified above. However, per the usual practice, prosecution of claims to these indicators as part of the lens blank, will depend upon sufficient support in the disclosure as filed, for their use in the lens blank per se.

The species are independent or distinct because they do not overlap in scope, they are not obvious variants, and as claimed they can have a materially different design, mode of operation, function or effect.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, **and a listing of all claims readable thereon, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an

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allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob K. Ackun Jr. whose telephone number is (571)272-4418. The examiner can normally be reached on Monday through Friday 8.30AM-5.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (571)272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

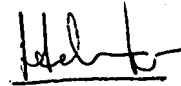
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated

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information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'J. Ackun Jr.', written over a horizontal line.

Jacob K. Ackun Jr.
Primary Examiner
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J.A.